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EXAMINER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/663,509
Filing Date: September 16, 2003
Appellant(s): DOYLE ET AL.

Scott D. Paul
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed 28 September 2009 appealing from the Office Action mailed 28 April 2009.

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(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is incorrect. A correct statement of the status of the claims is as follows:

Claims 1, 9, 13, and 17-28 are pending of which

1, 9, and 13 have been thrice rejected and

17-28 have been once rejected;

Claims 2-8, 10-12, and 14-16 are cancelled.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

WITHDRAWN REJECTIONS

The following grounds of rejection are not presented for review on appeal because they have been withdrawn by the examiner:

1. Claims 9 and 23-25 were rejected under 35 U.S.C. § 101, this rejection is withdrawn;
2. Claims 20 and 21 were rejected under the second paragraph of 35 U.S.C. § 112, this rejection is withdrawn.

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The appellant's statement of the grounds of rejection to be reviewed on appeal is substantially correct. The changes are as follows:

6. Claims 9, 13, 23, 25-26, and 28 were rejected under 35 U.S.C. § 103 for obviousness based upon Pitroda in view of Steele et al., U.S. Patent No. 7,016,877 (hereinafter Steele).

Appellant includes claim 24, however, claim 24 is not under this rejection.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

5,884,271	Pitroda	3-1999
6,487,540	Smith	11-2002
7,016,877	Steele	3-2006
2004/0083170	Bam	4-2004

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claims 1, 17, 18, 20, and 21 are rejected under 35 U.S.C. 102(b) as being anticipated by Pitroda, US 5,884,271.

Regarding Claim 1, Pitroda teaches a receipt management article of manufacture comprising: a computer storage medium configured to store receipt data from multiple disparate vendors (column 10, lines 4-32); communications logic for establishing a communicative link between

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the system and receipt data processing logic disposed within individual ones of said multiple disparate vendors (column 10, lines 26-39); and a receipt management processor programmed to moderate access to said store receipt data in said storage medium to an individual one of said multiple disparate vendors, wherein said storage medium further comprises a configuration for indexing said store receipt data according to at least one of a vendor identifier and a transaction identifier (column 12, line 21 – column 13, line 15).

Regarding Claim 17, Pitroda further teaches wherein said storage medium comprises a portable mass storage device (Figure 3).

Regarding Claim 18, Pitroda further teaches wherein said communicative link comprises a wireless link (column 10, lines 4-39).

Regarding Claim 20, Pitroda further teaches wherein each of said storage medium, communications logic and receipt management processor is disposed in a pervasive device (column 9, lines 49-63).

Regarding Claim 21, Pitroda further teaches wherein each of said storage medium, communications logic and receipt management processor is disposed in a personal article (column 9, lines 49-63).

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda, US 5,884,271.

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Regarding Claim 19, Pitroda does not explicitly teach security and authentication logic programmed to secure access to said receipt data through at least one of encryption, password protection and certificate validation and authentication. However, Pitroda teaches that the *UET card also includes security means... for preventing unauthorized access to the information stored in the memory means of the universal electronic transaction card* (column 4, lines 10-14). Also, Pitroda teaches *access to information stored in the card... can be blocked, unless the proper authorization code is entered* (column 14, lines 7-18). Therefore, it is obvious to one of ordinary skill in the art at the time of the invention that an authorization code or password is used to access information.

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Bam, US 2004/0083170.

Regarding Claim 22, Pitroda does not explicitly teach wherein said personal article comprises a key chain fob. However, Bam discloses that the *wallet now carries different pieces of information and service provider information, such as identification cards, payment cards... Key chains are also being used to carry tags containing these pieces of information* ([0006]). Also, Bam discloses *the system offers... digital receipt management* ([0027]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Bam to allow for a key chain hook in order to provide convenience to the consumer.

Claims 9, 13, 23, 25, 26, and 28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Steele, US 7,016,877.

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Regarding Claims 9 and 13, Pitroda teaches a method and computer-readable instructions, respectively, for electronic receipt management comprising the steps of: establishing a communicative link between a data store of electronic receipts from multiple disparate vendors, and an individual one of said multiple disparate vendors (column 10, lines 4-39).

Pitroda does not explicitly teach locating a specific electronic receipt stored within said data store which corresponds to an identifier provided by said individual one of said multiple disparate vendors. However, Pitroda teaches *a transaction memory 410 is provided to store all transaction receipts in electronic form to eliminate or reduce paper receipts... database management 414... POS ID numbers... sales identifications* (column 12, lines 21-32 and lines 60-67; Figure 2). It is old and well-known that receipts have identification numbers given by the vendors as the vendors have their own accounting. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to locate receipts by vendor identifier in order to maintain consistency.

Pitroda does not explicitly teach transmitting said located specific electronic receipt to said individual one of said multiple disparate vendors over said established communicative link. However, Pitroda discloses that the CIU can read information from the UET card and that the *CIU unit may include an interface for a point of sale computer* (column 13, lines 1-16; Figure 7). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to transmit a receipt to the vendor if needed.

Pitroda does not teach authenticating said individual one of said multiple disparate vendors. However, Steele discloses vender authentication (column 16, line 46 – column 17, line 18). Pitroda teaches that the *UET card also includes security means... for preventing unauthorized access to the information stored in the memory means of the universal electronic transaction*

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card (column 4, lines 10-14). Also, Pitroda teaches *access to information stored in the card... can be blocked, unless the proper authorization code is entered* (column 14, lines 7-18).

Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Steele to include vendor authentication in order to prevent unauthorized access to the stored information.

Regarding Claims 23 and 26, Pitroda further teaches wherein said establishing step comprises the step of configuring a wireless communications link with said individual one of said multiple disparate vendors (column 10, lines 4-39).

Regarding Claims 25 and 28, Pitroda further teaches wherein said establishing step comprises the step of inserting a portable storage medium containing said data store into a reader coupled to said individual one of said multiple disparate vendors (column 10, lines 4-39).

Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Steele and further in view of Smith, US 6,487,540.

Regarding Claims 24 and 27, Pitroda does not teach wherein said establishing step comprises the step of configuring a wirebound communications link with said individual one of said multiple disparate vendors. However, Smith discloses that a *receipt is transferred from the vendor to the WPD via a wired or wireless Internet connection* (column 3, lines 63-67). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Smith to include wired connection as well in order to provide convenience to the customer.

(10) Response to Argument

**THE REJECTION OF CLAIMS 1, 17-18, AND 20-21 UNDER 35 U.S.C. § 102 FOR
ANTICIPATION BASED UPON PITRODA**

As to Appellant's remarks (page 9 of Appeal Brief) reproduced from the First Response, Appellant concedes that Pitroda teaches electronically storing transaction receipts. However, Appellant then selectively cites that Pitroda discloses that such transactions can be downloaded to a PC or central computer. Appellant further remarks *with the exception of discussing that these transactions can later be analyzed, Pitroda discusses little else with regard to the receipts.* Examiner notes, that a prior art reference discloses more than the instant invention does not negate the fact that the particular limitations are indeed disclosed. Therefore, Pitroda as a prior art reference cannot be dismissed.

Page 9, line 15 - page 10, line 3 of the Appeal Brief are also reproduced from the First Response but refer to claims 9 and 13, which have been amended and subsequently have been rejected under § 103 over Pitroda in view of Steele. Therefore, since this section is for the rejection of claim 1 under § 102, this reproduced paragraph is misplaced.

Page 10, line 5 – page 11, line 10 of the Appeal Brief discuss inherency. Appellant has misapprehended what Examiner asserted as inherent. The statement is: **Locating a specific piece of information in a database is inherent.** Examiner maintains this statement of inherency. It appears that Appellant has widened the scope of this statement to include “techniques that can be used to obtain information from a database” (page 11, line 7 of Appeal Brief). Examiner clarifies that this statement of inherency does not include any techniques for

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locating the specific piece of information, but simply that a database stores information for the purpose of accessing said information. In other words, as noted preceding the statement of inherency in the Second Office Action: **A database by definition is a collection of data organized in such a way that facilitates access or retrieval of the data, among other things.** This is what a database is and its function. Information or data is not stored in a database just for the sake of storing information without the capability of accessing or retrieving the information. But there are options on how to set up a database. Therefore, Examiner did not include in the statement of inherency any techniques of retrieving data. For example, a filing cabinet is used to store files. This is the function of a filing cabinet. How the filing cabinet is organized in order to facilitate retrieval is varied. Two common ways are that it can be organized alphabetically or numerically.

Page 11, line 12 – page 12, line 25 of the Appeal Brief recite limitations that are no longer of independent claim 1. Therefore, since this section is for the rejection of claim 1 under § 102, these paragraphs are misplaced.

Page 13, lines 1-3 of the Appeal Brief assert that “the Examiner did not directly respond to any of the above-reproduced arguments” (page 13, lines 2-3 of Appeal Brief). Examiner points out the three cited paragraphs that Appellant himself chose: page 10, lines 7-15; page 11, lines 19-25; page 12, lines 12-18 of the Appeal Brief. All three paragraphs state “Applicant argues... [quote of Applicant’s concern]. Examiner respectfully disagrees. Pitroda teaches... [citation with explanation].” Furthermore, in the Third Office Action, Examiner supplied further citations and explanations at the individual rejections deeming complete and responsive. Appellant first

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asserted above via telephone message of 22 July 2009. Examiner returned telephone call and offered to provide a Supplemental Action with further explanation. Appellant refused such.

Page 13, lines 12-19 of the Appeal Brief selectively cites lines pertaining to other aspects of the Pitroda reference. Again Examiner notes, that a prior art reference discloses more than the instant invention does not negate the fact that the particular limitations are indeed disclosed. Therefore, Pitroda as a prior art reference cannot be dismissed.

Now to the particular limitations of independent claim 1, the rejection repeated below:

Regarding Claim 1, Pitroda teaches a receipt management article of manufacture comprising: a computer storage medium configured to store receipt data from multiple disparate vendors (column 10, lines 4-32); communications logic for establishing a communicative link between the system and receipt data processing logic disposed within individual ones of said multiple disparate vendors (column 10, lines 26-39); and a receipt management processor programmed to moderate access to said store receipt data in said storage medium to an individual one of said multiple disparate vendors, wherein said storage medium further comprises a configuration for indexing said store receipt data according to at least one of a vendor identifier and a transaction identifier (column 12, line 21 – column 13, line 15).

Appellant argues that Pitroda does not teach *a receipt management processor programmed to moderate access to said store receipt data in said storage medium to an individual one of said multiple disparate vendors, wherein said storage medium further comprises a configuration for*

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indexing said store receipt data according to at least one of a vendor identifier and a transaction identifier (page 13, lines 6-10 of Appeal Brief).

First, Pitroda teaches *corresponding to each card, a transaction memory area 410 is provided to store all transaction receipts in electronic form to eliminate or reduce paper receipts* (column 12, lines 21-24).... *The UET card software also includes an operating system 412, memory management 413, database management 414, display formats and associated management 415, analysis algorithms and procedures 416* (column 12, lines 27-30). Examiner notes that the UET card has an operating system. A processor requires an operating system. Nonetheless, column 11, lines 37-38 explicitly disclose that the UET card includes a microcontroller. Figure 3 discloses same.

Second, Pitroda teaches a POS (point of sale, i.e. vendor) database to include one or more POS ID numbers, credit card company numbers, service numbers, and department identifications or sales identifications, or the like (column 12, lines 62-67). As noted above in the inherency discussion, since *a database by definition is a collection of data organized in such a way that facilitates access or retrieval of data, among other things, and locating a specific piece of information in a database is inherent*, that the instant database is indexed or organized by a vendor identifier or a transaction identifier does not effectively serve to patentably distinguish the claimed invention over the prior art. Also, that Pitroda does not use the same words as the instant limitation does not effectively serve to patentably distinguish the claimed invention over the prior art. For example, the limitation recites a vendor identifier or a transaction identifier, whereas Pitroda recites POS ID numbers or sales identifications. Therefore, Pitroda teaches *a receipt management processor programmed to moderate access*

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to said store receipt data in said storage medium to an individual one of said multiple disparate vendors, wherein said storage medium further comprises a configuration for indexing said store receipt data according to at least one of a vendor identifier and a transaction identifier.

THE REJECTION OF CLAIM 19 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED UPON PITRODA

Claim 19 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda, US 5,884,271.

Regarding Claim 19, Pitroda does not explicitly teach security and authentication logic programmed to secure access to said receipt data through at least one of encryption, password protection and certificate validation and authentication. However, Pitroda teaches that the *UET card also includes security means... for preventing unauthorized access to the information stored in the memory means of the universal electronic transaction card* (column 4, lines 10-14). Also, Pitroda teaches *access to information stored in the card... can be blocked, unless the proper authorization code is entered* (column 14, lines 7-18). Therefore, it is obvious to one of ordinary skill in the art at the time of the invention that an authorization code or password is used to access information.

It appears that Appellant argues that it would not be viable to incorporate security measures or authentication logic into Pitroda in order to access receipt data. As noted above and in the citations in their entirety, Pitroda clearly teaches security mechanisms. *A reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art.* In re Delisle, 160 USPQ 806 (CCPA 1969).

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**THE REJECTION OF CLAIM 22 UNDER 35 U.S.C. § 103 FOR OBVIOUSNESS BASED
UPON PITRODA IN VIEW OF BAM**

Claim 22 is rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Bam, US 2004/0083170.

Regarding Claim 22, Pitroda does not explicitly teach wherein said personal article comprises a key chain fob. However, Bam discloses that the *wallet now carries different pieces of information and service provider information, such as identification cards, payment cards... Key chains are also being used to carry tags containing these pieces of information* ([0006]). Also, Bam discloses *the system offers... digital receipt management* ([0027]). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Bam to allow for a key chain hook in order to provide convenience to the consumer.

It appears that Appellant argues that it would not be viable to modify Pitroda to allow for a key chain hook design. As cited in the rejection of claim 1 from which claim 22 depends, Pitroda teaches that *the size of the card can remain small enough to carry it in the pockets* (column 10, lines 23-25). *A reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art.* In re Delisle, 160 USPQ 806 (CCPA 1969). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Bam to allow for a key chain hook in order to provide convenience to the consumer.

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**THE REJECTION OF CLAIMS 9, 13, 23, 25-26, AND 28 UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON PITRODA IN VIEW OF STEELE**

As to Appellant's argument that "the Examiner's analysis is not entirely clear as to what rationale the Examiner is employing" (page 16, lines 14-15 of Appeal Brief), Examiner asserts that the obviousness rejection is very clear. There is not a requirement to place a letter, e.g., (A), in front of the rejection to identify rationale.

Now to the limitations of independent claims 9 and 13, Appellant demarcates three limitations in the pages 18-21 under this section of the Appeal Brief: vendor identification numbers, transmitting a receipt to a vendor, and authentication.

As to Appellant's remarks regarding vendor identification numbers (pages 18-19), it appears that Appellant forwards the inventive concept of establishing identification numbers for "Vendor A and Vendor B, both with two stores," in order to be able to ascertain which of the four stores a purchase was made. Pitroda teaches *a transaction memory 410 is provided to store all transaction receipts in electronic form to eliminate or reduce paper receipts... database management 414... POS ID numbers... sales identifications* (column 12, lines 21-32 and lines 60-67; Figure 2). Examiner asserts that Pitroda teaches keeping transactions separate in order to retrieve the exact receipt being sought. Examiner further asserts that it would be reasonable for one skilled in the art to infer that Pitroda would keep four stores separate in order to be able to retrieve the appropriate receipt. *In considering disclosure of reference patent, it is pertinent to point out not only specific teachings of patent but also the reasonable inferences which one skilled in the art would logically draw therefrom.* In re Shepard, 138 USPQ 148 (CCPA 1963).

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As to Appellant's remarks regarding transmitting a receipt to a vendor (pages 20-21), it appears that Appellant forwards the inventive concept of presenting a receipt to a vendor. Examiner notes the well known manual step of presenting a receipt to a vendor as proof of purchase in order to return the purchase. That this manual step is now automated to an electronic transmission does not effectively serve to patentably distinguish the claimed invention over the prior art. *It is not 'invention' to broadly provide a mechanical or automatic means to replace manual activity which has accomplished the same result.* In re Venner, 120 USPQ 192 (CCPA 1958), In re Rundell, 9 USPQ 220 (CCPA 1931).

As to Appellant's remarks regarding authentication (page 21), it appears that Appellant concedes that Pitroda teaches the limitation of authentication. Therefore, it is unclear what Appellant's argument is regarding the limitation of authentication. Examiner notes that the bolded words of lines 12 and 16 of page 21 are not in original.

**THE REJECTION OF CLAIMS 24 AND 27 UNDER 35 U.S.C. § 103 FOR
OBVIOUSNESS BASED UPON PITRODA IN VIEW OF STEELE AND SMITH**

Claims 24 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Pitroda in view of Steele and further in view of Smith, US 6,487,540.

Regarding Claims 24 and 27, Pitroda does not teach wherein said establishing step comprises the step of configuring a wirebound communications link with said individual one of said multiple disparate vendors. However, Smith discloses that a *receipt is transferred from the vendor to the WPD via a wired or wireless Internet connection* (column 3, lines 63-67). It would have been

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obvious to one of ordinary skill in the art at the time of the invention to modify the invention of Pitroda with that of Smith to include wired connection as well in order to provide convenience to the customer.

It appears that Appellant argues that it would not be viable to modify the Pitroda and Steele combination with that of Smith to use a wirebound communications link with vendors. As cited in the rejection of claims 9 and 13, from which claims 24 and 27 respectively depend, Pitroda teaches *[w]hen the metal contacts of the UET card are connected to the corresponding contacts or port of the CIU...* (column 13, lines 1-16; Figure 7). *A reference is to be considered not for what it expressly states, but for what it would reasonably have suggested to one of ordinary skill of the art.* In re Delisle, 160 USPQ 806 (CCPA 1969). Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify the Pitroda and Steele combination with that of Smith to include wired connections as well in order to provide convenience to the customer.

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(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

/Debra Antonienko/
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